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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,059	08/01/2001	Douglas B. Quine	F-298	4432
919	7590	01/07/2005	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			LIN, WEN TAI	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,059

Applicant(s)

QUINE ET AL.

Examiner

Wen-Tai Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001 and 25 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 22, 27-29, 44, 46-49 and 62 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 9-21, 23-26, 30-43, 45, 50-61 and 63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/12/02-11/25/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-63 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6832246 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: (1) prescribing at a remote computer (i.e., a forwarding server) for associating a disfavored e-mail address with a forwarding e-mail

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address; (2) the email forwarding computer has a unique e-mail address (i.e., other than the forwarding e-mail address); and (3) when receiving a message with an intended email address (i.e., registered as a disfavored e-mail address), send the message to the forwarding e-mail address from the remote computer if the intended e-mail address has an associated with a forwarding e-mail address registered with the remote computer.

Note that although the claim language in the instant application does not teach parsing the intended e-mail address from the e-mail message in the remote computer, such a limitation is considered obvious with the claim because it takes a nominal parsing step to extract the intended email address which is otherwise embedded in the message.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application

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filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Schoeffler [U.S. PGPub 20010049745].

5. As to claim 1, Schoeffler teaches the invention as claimed including: a method to forward messages to forwarding e-mail addresses [Abstract; Figs 1-3], the method comprising the steps of:

associating a plurality of disfavored e-mail addresses [e.g., the old address] with corresponding forwarding e-mail addresses in an e-mail forwarding computer;

providing an electronic address for receiving messages at the e-mail forwarding computer, said messages relating to any of the plurality of disfavored e-mail addresses [paragraphs 29-30];

receiving said messages at the electronic address;

identifying, with the e-mail forwarding computer, a disfavored e-mail address in a received message, the disfavored e-mail address being other than the electronic address for the e-mail forwarding computer;

determining, with the e-mail forwarding computer, a forwarding e-mail address associated with the disfavored e-mail address; and

forwarding at least a portion of the received message from the e-mail forwarding computer to the associated forwarding e-mail address [8-10, Fig.1; paragraphs 39 -41].

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6. As to claim 2, Schoeffler further teaches that the step of receiving said messages further comprises:

receiving said messages as redirected to the electronic address of the e-mail forwarding computer by a server associated with a domain address of the disfavored e-mail address [page 11, claim 30; i.e., the server to which the communication was sent is the mail server associated with the disfavored e-mail address].

7. As to claim 22, since the features of this claim can also be found in claims 1-2, it is rejected for the same reasons set forth in the rejection of claims 1-2 above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 6-8, 27-29 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoeffler [U.S. PGPub 20010049745], as applied to claims 1-2 and 22 above, further in view of Official Notice.

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10. As to claim 3, Schoeffler does not specifically teach the step of providing an electronic address includes providing an Internet web site for inputting messages including disfavored e-mail addresses; and the step of receiving said messages includes receiving said messages from the Internet web site.

However, Official Notice is taken that composing and mailing an email from a web site is well known in the art. For example, a Yahoo subscriber may utilize the mailbox services to compose mail messages and send to a invalid email address therefrom.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include emails that are sent from a web site in Schoeffler's forwarding because by doing so it would greatly enhance Schoeffler's customer base.

11. As to claims 6-8, Schoeffler teaches that the plurality of disfavored e-mail addresses are entered into an associated database with the forwarding server [e.g., paragraphs 30 and 39].

Schoeffler does not specifically teach the details of the registration process, which includes requesting, confirming, authenticating and identifying steps using encryption verification.

However, Official Notice is taken that the above registration steps are well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to follow the steps of requesting, confirming, authenticating and

identifying because the steps ensure that the information registered is correct and coming from the right persons.

12. As to claims 27-29 and 47-49, since the features of these claims can also be found in claims 1-3, 6-8, 22 and 46, they are rejected for the same reasons set forth in the rejection of claims 1-3, 6-8, 22 and 46 above.

13. Claims 44, 46 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoeffler [U.S. PGPub 20010049745], as applied to claims 1-3, 6-8, 22, 27-29 and 47-49 above.

14. As to claim 44, Schoeffler further teaches the steps of:

sending an e-mail message from an originator to an e-mail address at an e-mail system server for an e-mail service provider [2-3, Fig.1];

determining at the e-mail system server that the e-mail address is undeliverable;

returning the undeliverable message to the originator [4, Fig.1]; and

sending the undeliverable e-mail message from the originator to the e-mail forwarding computer whereby the undeliverable message becomes the received message at the e-mail forwarding computer [5, Fig.1].

Schoeffler does not specifically teach including a prompt, along with the returned undeliverable message from the e-mail system server to the originator, to send the undeliverable message to the electronic address for the e-mail forwarding computer.

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However, in another embodiment, Schoeffler teaches that the message may be redirected to the forwarding server [col.11, claim 30]. That is, in this scenario the email system server must have known the email forwarding server's address. As such, it becomes obvious to one of ordinary skill in the art that, as an option, the email system could have returned the message to the original sender with information about the email forwarding service with which the recipient have registered and prompting the original sender to forward the message because by so doing the email system server would have passed along the forwarding information to the original sender, thereby avoiding a subsequent email (for the same recipient) from sending to the same email system server.

15. As to claims 46 and 62, since the features of these claims can also be found in claims 1, 22 and 44, they are rejected for the same reasons set forth in the rejection of claims 1, 22 and 44 above.

16. Claims 4-5, 9-21, 23-26, 30-43, 45, 50-61 and 63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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Reilly [U.S. Pat. No. 6427164];

McDowell et al. [U.S. Pat. No. 6438583]; and

Salzfass et al. [U.S. PGPub 20020042815].

18. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:


(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

January 2, 2005


1/2/05